

REMARKS/ARGUMENTS

This Amendment is being filed concurrently with a Request for Continued Examination (RCE). With this Amendment, Applicant amends claims 1, 5 and 9. No new matter is added. Claims 1, 3-6 and 9-17 are all the claims currently pending in the application. However, claims 10-17 are withdrawn from consideration. Based on the foregoing amendments and the following remarks, Applicant respectfully requests reconsideration of the application and allowance of the claims.

I. Rejection of Claims 1, 3-6 & 9 Under 35 U.S.C. § 112, Second Paragraph

Claims 1, 3-6 and 9 stand rejected under 35 U.S.C. § 112, second paragraph as allegedly being indefinite. (See pgs. 2-3 of the Office Action)

Applicant herein amends independent claims 1 and 9 and submits that these self-explanatory claim amendments overcome the § 112, second paragraph rejection. Applicant therefore respectfully requests the Examiner to reconsider and withdraw the § 112, second paragraph rejection of claim 1 and its dependent claims 3-6 as well as independent claim 9.

Regarding the Examiner's assertion that independent claims 1 and 9 are unclear on the basis of "whether the filling of the prescriptions ... is part of the claimed invention" Applicant points out that claim 1 recites, *inter alia*, that "in response to the determination revealing that at least one of the plurality of prescriptions is fillable in the fully automated manner, the method further comprises selecting a first subset of said workstations *to fill* the at least one *prescription* entirely" and "in response to the determination revealing that the at least one prescription is not fillable in the fully automated manner, the method further comprises selecting a second subset of said workstations *to semi-automatically or manually fill* the at least one *prescription* ...". Independent claim 9 recites features analogous to the above-mentioned features of claim 1.

In contrast to the Examiner's assertion, Applicant submits that a skilled artisan would clearly understand the recitations of independent claims 1 and 9 without requiring further explanation. In this regard, Applicant points out that MPEP § 2173.04 states that "[b]readth of a claim is not to be equated with indefiniteness." As such, Applicant is not required to amend claims 1 and 9 in the manner suggested by the Examiner.

For at least the foregoing reasons, Applicant requests reconsideration and withdrawal of the § 112 second paragraph rejection of claims 1, 3-6 and 9.

II. Rejection of Claims 1, 3-6 & 9 Under 35 U.S.C. § 102(b)

Claims 1, 3-6 and 9 are rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Lasher et al. (U.S. Patent No. 5,771,657; hereinafter “Lasher”).

In contrast to amended independent claim 1, Lasher does not teach or suggest and is altogether silent regarding a method of discriminating between orders comprising, *inter alia*: (A) *determining* a set of workstations for each prescription based on *evaluating* a queue of orders to determine whether a plurality of prescriptions within each order is fillable in a fully automated manner or not; and (B) wherein in response to the determination revealing that at least one of a plurality of prescriptions is fillable in the fully automated manner, the method further comprises selecting a *first subset* of said *workstations to fill* the at least one *prescription entirely automatically*, wherein *selecting said first subset of workstations comprises excluding a pharmacist review workstation for reviewing* a respective filled order by a pharmacist. In contrast to claim 1, Lasher at most discloses that when the system therein determines that an order relates to prescriptions that are to be dispensed and filled automatically, the automated drug dispensing machines 23 may be utilized to automatically dispense tablets or capsules into prescription bottles. (Col. 3, lines 47-51, Col. 4, lines 10-12 & Col. 6, lines 10-13). However, Lasher describes that during the automated filling process that bar codes of the bottles are read and verified by a bar code reader in a robotic arm 79. (Col. 11, lines 7-9) In this regard, Lasher explains that when the system detects a discrepancy between the read bar code and a bar code in a literature pack, an order consolidation and packing (OCP) station places the bottle in a bottle stream conveyor 108 to be sent to a bottle quality assurance area 109 where “the bottle is **manually** and electronically **inspected**.” (Col. 11, lines 8-12 & Col. 10, lines 52-60) (emphasis added)

Additionally, Lasher explains that if the system detects that a bottle does not contain the “correct number of tablets ... by the automatic dispensing machines” the bottle(s) is sent to the bottle quality assurance area 109. (Col. 11, lines 12-16) Lasher also explains that when the system detects that it failed to properly cap the bottle this failure is recorded and a Pharmacy

Automation Computer (PAC) will direct the OCP station to place the corresponding prescription bottle in the bottle stream for transport to the bottle quality assurance area 109. (Col. 11, lines 16-21)

In view of the foregoing, Lasher at most discloses that “[i]f an automatic drug dispensing machine 23 detects an error” during the process of filling a prescription, the automatic drug dispensing machine 23 will signal the error to the PAC 10 which arranges for the bottle to be transported to the bottle quality assurance area 109. (Col. 11, lines 16-21 & Col. 14, lines 36-44)

Lasher describes that the bottle quality area 109 has “**several stations** at which **pharmacists**” inspect the contents of the bottles and may utilize a display on the “**pharmacist’s terminal**” when performing the inspection.¹ (Col. 12, lines 1-12) (emphasis added)

In contrast to independent claim 1, Lasher at most discloses that when the system therein uses automatic dispensing machines 23 to automatically fill orders of prescriptions, the system “automatically divert[s] the orders and bottles for **manual inspection**” by a pharmacist via a pharmacist terminal when the automatic dispensing machines 23 detect errors or problems. (Col. 15, lines 65-67 & Col. 16, lines 1-3) (emphasis added)

Since Lasher discloses that a pharmacist terminal may be used by a pharmacist when problems arise during automatic filling of prescriptions by the automatic dispensing machines 23, Lasher fails to teach or suggest “in response to determining that a prescription is fillable in a *fully automated manner, selecting a first subset of workstations* to fill the prescription *entirely automatically*, in which selecting *the first subset of workstations* comprises *excluding a pharmacist review workstation for reviewing a filled order by a pharmacist*, as recited by independent claim 1.

In view of the foregoing, when Lasher selects an order to fill prescriptions *automatically* by its automatic dispensing machines 23 if a problem or error is detected by the automatic dispensing machines 23, a pharmacist review terminal **is included** in the equipment so as to facilitate a **manual** review and inspection of an order that was designated as being filled automatically. On the other hand, independent claim 1 recites that when an evaluation reveals

¹ See also Col. 15, lines 52-54 of Lasher explaining that the computers 201 and 203 provide information to pharmacists about orders and prescriptions received at quality assurance areas.

that the prescriptions are to be filled *entirely automatically* a pharmacist review workstation *is excluded* for reviewing a respective filled order by a pharmacist. The pharmacist review workstation is not involved when the determination reveals that the order is to be filled automatically according to the recitations of claim 1. Lasher does not contemplate such a feature for the reasons discussed above given that Lahser indeed utilizes a pharmacist's terminal when an error or problem is detected even when the prescriptions are to be filled automatically by the automatic dispensing machines 23.

For at least the foregoing reasons, Applicant submits that Lasher does not teach or suggest all of the features of claim 1. Applicant therefore respectfully requests reconsideration and withdrawal of the § 102(b) rejection of independent claim 1 and its dependent claims 3-6.

Since independent claim 9 contains features that are analogous to, though not necessarily coextensive with, the features recited in independent claim 1, Applicant submits that independent claim 9 is patentable at least for reasons analogous to those submitted for claim 1.

III. Conclusion

In view of the foregoing remarks, Applicant submits that all of the claims of the present application are in condition for allowance. It is respectfully requested that a Notice of Allowance be issued in due course. Examiner Porter is encouraged to contact Applicant's undersigned attorney to resolve any remaining issues in order to expedite examination of the present application.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fee required therefor (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

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